

PATENT
Atty. Dkt. No. ROC920010091US1
MP9 Ref. No.: IBMK10091

REMARKS

This is intended as a full and complete response to the Office Action dated March 25, 2005, having a shortened statutory period for response set to expire on June 25, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-36 are pending in the application. Claims 1-36 remain pending following entry of this response. Claims 1-3, 6-7, 9, 12, 16-20, 22-23, 26-27, 29 and 32 have been amended. Applicants submit that the amendments do not introduce new matter.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 3, 4, 6, 20, 23, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Greyzck et al.*, U.S. Patent 5,361,354 (hereinafter referred to as *Greyzck*), in view of *Brandes*, U.S. Patent 5,946,484.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the first and third criteria.

Regarding claims 1, 3, 4, 6, 20, 23, 24 and 26, *Greyzck*, in view of *Brandes* fails to teach or suggest generating, from optimized object code, the optimized version of source code, wherein the optimized version of source code corresponds to an original version of the source code, modified to reflect an optimization in the optimized object code. Specifically, the techniques of *Brandes* fail to generate object code that has a relationship to an original version of the source code.

Brandes discloses generating source code for common patterns of object code. *Brandes*, Abstract. However, the relationship between source code and object code is

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not one-to-one. Thus, many different versions of source code will compile to an identical sequence of machine instructions (i.e., object code). As a result, decompiling object code does not produce the original source that was used to generate the given object code. In other words, the source code generated by the techniques taught by *Brandes* have no relationship to the original source code, in fact *Brandes* is directed to situations where the original source is lost, or otherwise unavailable. Therefore, the source code generated using the techniques disclosed in *Brandes* is not likely to bear any correspondence with the original source code.

Thus, *Brandes* (when combined with *Greyzck*) fails to teach or suggest generating, from optimized object code, the optimized version of source code, wherein the optimized version of source code corresponds to an original version of the source code, modified to reflect an optimization in the optimized object code.

Further, without such a correspondence, one skilled in the art would lack a motivation to combine teachings of *Brandes* with *Greyzck*. For example, source code typically includes a number of arbitrary comments, variable names, procedure call names, method names, defined names (e.g., #define statements in C++), and the like. As stated, the techniques disclosed by *Brandes*, however, fail to provide any connection between the source code it generates and the original source code. By combining *Brandes* with *Greyzck*, the variable names, method names, and the like would fail to match between the original source code and the version using generated according to *Brandes*. Accordingly, Applicants respectfully submit that the suggested combination lacks motivation. Applicants, therefore, respectfully request that the rejection be withdrawn, and that claims 1, 3, 4, 6, 20, 23, 24 and 26 be allowed.

Claims 8, 9, 12, 14-16, 18, 19, 28, 29, 32, 35 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Greyzck*, in view of *Brandes*, and further in view of *Percival et al.*, U.S. Patent 6,226,652 (hereinafter referred to as *Percival*).

Applicants respectfully traverse this rejection.

Regarding claims 8, 9, 12, 14-16, 18, 19, 28, 29, 32, 35 and 36, Applicants submit that *Greyzck*, in view of *Brandes*, and further in view of *Percival* fails to teach or suggest each and every limitation recited in these claims. As set forth above, *Greyzck*,

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in view of *Brandes* fails to teach or suggest generating, from optimized object code, the optimized version of source code, wherein the optimized version of source code corresponds to an original version of the source code, modified to reflect an optimization in the optimized object code. Applicants assert that *Percival* also fails to teach this limitation. Thus, Applicants submit that the combination of *Greyzck*, in view of *Brandes* in further view of *Percival* does not teach or suggest each and every limitation of these rejected claims. Accordingly, Applicants submit that claims 8, 9, 12, 14-16, 18, 19, 28, 29, 32, 35 and 36 are patentable over *Greyzck*, in view of *Brandes* alone, or in further view of *Percival*, and therefore request that the rejection of these claims be withdrawn.

Claims 2, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Greyzck*, in view of *Brandes*, and further in view of *IBM Technical Disclosure Bulletin NN9305305* (hereinafter referred to as *IBM_TDB*).

Applicants respectfully traverse this rejection. Claims 2, 21 and 22 depend from one of claims 1 or 20. As set forth above, *Greyzck*, in view of *Brandes* fails to teach or suggest generating, from optimized object code, the optimized version of source code, wherein the optimized version of source code corresponds to an original version of the source code, modified to reflect an optimization in the optimized object code. Applicants assert that *IBM_TDB* also fails to teach this limitation. Thus, Applicants submit that the combination of *Greyzck*, in view of *Brandes* in further view of *IBM_TDB* does not teach or suggest each and every limitation of these rejected claims. Accordingly, Applicants submit that claims 2, 21, and 22 are patentable over *Greyzck*, in view of *Brandes* alone, or in further view of *IBM_TDB*, and therefore request that the rejection of these claims be withdrawn.

Claims 13, 17, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Greyzck*, in view of *Brandes*, as applied to claims 12, 16 and 32 above, and further in view of *Percival*.

The Examiners rejection, as set forth above, purports to be based on the combination of *Greyzck*, *Brandes*, and *Percival*. However, the substance of the rejection of claim 13 references *IBM_TDB*, as does the corresponding rejections of claims 17, 33 and 34 by reference. Applicants' believe that the Examiner is rejecting these claims

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using the combination of *Greyzck*, *Brandes*, and *Percival*, (as applied to claims 12, 16, and 32) in further view of *IBM_TBD*.

Applicants request that the Examiner clarify this rejection. Nevertheless, presuming that the Examiner is rejecting these claims using a combination of *Greyzck*, *Brandes*, *Percival* and *IBM_TBD*, Applicants respectfully traverse the rejection. Claims 13, 17, 33 and 34 depend from one of claims 12, 16, or 32. As set forth above, *Greyzck*, in view of *Brandes* fails to teach or suggest generating, from optimized object code, the optimized version of source code, wherein the optimized version of source code corresponds to an original version of the source code, modified to reflect an optimization in the optimized object code. Applicants assert that *Percival* and *IBM_TBD* also fail to teach this limitation. Thus, Applicants submit that the combination of *Greyzck*, in view of *Brandes* in further view of *IBM_TBD* and *Percival* does not teach or suggest each and every limitation of these rejected claims. Accordingly, Applicants submit that claims 13, 17, 33 and 34 are patentable over the combination of *Greyzck*, *Brandes*, *Percival*, and *IBM_TBD*, and therefore request that the rejection of these claims be withdrawn.

Claims 5, 7, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Greyzck*, in view of *Brandes*, and further in view of *Mattson, Jr. et al.*, U.S. Patent 6,430,741 (hereinafter referred to as *Mattson*).

Applicants respectfully traverse this rejection. Claims 5, 7, 25 and 27 each ultimately depend from one of claims 1 or 20. As set forth above, *Greyzck*, in view of *Brandes* fails to teach or suggest generating, from optimized object code, the optimized version of source code, wherein the optimized version of source code corresponds to an original version of the source code, modified to reflect an optimization in the optimized object code. Applicants assert that *Mattson* also fails to teach this limitation. Thus, Applicants submit that the combination of *Greyzck*, in view of *Brandes* in further view of *Mattson* does not teach or suggest each and every limitation of these rejected claims. Accordingly, Applicants submit that claims 5, 7, 25 and 27 are patentable over *Greyzck*, in view of *Brandes*, alone, or in further view of *Mattson*, and therefore request that the rejection of these claims be withdrawn.

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Claims 10, 11, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Greyzck*, in view of *Brandes*, as applied to claims 1, and further in view of *Shrader et al.*, U.S. Patent Application Publication US 2003/0005349 (hereinafter referred to as *Shrader*).

Shrader was filed on June 29, 2001 and first published on January 2, 2003. The present application was filed on July 30, 2001. Thus, *Shrader* is available as a reference only under 35 U.S.C. § 102(e). *Shrader* and the present invention, at the time the present application was made, owned by the same entity, or subject to an obligation of assignment to the same entity, as shown in a Statement of Common Ownership re: *Shrader* submitted herewith. Under 18 U.S.C. § 103(c), the Statement of Common Ownership removes *Shrader* as a reference under 35 U.S.C. § 102(e). Therefore, Applicant respectfully requests that the rejection based upon *Shrader* be withdrawn and that claims 10, 11, 30 and 31 be allowed.

Conclusion

Having addressed all issues set out in the office action, Applicants submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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